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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,714	08/17/2001	Dana Howard Jones	513612000200	6243

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EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
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3622

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10/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/932,714	Applicant(s) JONES, DANA HOWARD	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 2,7,8,12-16,19-23 and 27-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-11,17,18 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 07/20/2007.
2. Claims 2, 7, 8, 12-16, 19-23, and 27-44 have been cancelled. Newly submitted claims 45-55 are withdrawn from consideration. Claims 1, 3-6, 9-11, 17, 18, and 24-26 are presented for examination.
3. *Newly submitted claims 45-55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:*
 - I. *Claims 1, 3-6, 9-11, 17, 18, and 24-26, drawn to offering incentives for purchases of media products or services over a communications network comprising, selecting a sponsor message based on the number of times the message has been previously presented, offering a media product or service for sale, offering an incentive if the consumer agrees to interact with an interposed communication, receiving the request for interaction, presenting a query to the consumer, providing the incentive to the consumer, recording the transaction event, and receiving payment from the sponsor of the message, classified in class 705, subclass 14.*
 - II. *Claims 45-55, drawn offering incentives related to purchases of media products or services comprising, associating sponsor messages with consumer demographic criteria, receiving from the consumer demographic information about the consumer, and*

verifying that the associated consumer demographic criteria of the selected sponsor message matches the demographic information received from the consumer, classified in class 705, subclass 14.

4. *Inventions of group I and group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because group I does not require associating sponsor messages with consumer demographic criteria, receiving from the consumer demographic information about the consumer, and verifying that the associated consumer demographic criteria of the selected sponsor message matches the demographic information received from the consumer. The subcombination has separate utility such as group II requiring that the step of selecting includes verifying that the associated consumer demographic criteria of the selected sponsor message matches the demographic information received from the consumer, and that that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the sponsor message, which does not involve selecting the sponsor message based just on the total number of times, which the sponsor message has been previously presented is less than a number of predetermined transaction cycles*

contracted by the sponsor of the sponsor message. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-55 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. *Amendments to the claims have been entered and considered.*

Claim Rejections - 35 USC § 112

6. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

7. *Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

It is unclear if the Applicant means the sponsor message is the same thing as the offer to a consumer for the media product or service for sale. It is interpreted to mean that these two are different things in that the sponsor message is an advertisement and the offer is information regarding the cost of purchasing a product or service.

Appropriate clarification is required.

It is unclear what the Applicant means by in response to receiving the request from the consumer, facilitating the display of the selected sponsor message to the customer. Specifically, it is unclear if the sponsor message is actually displayed to the consumer by this limitation. This limitation is interpreted to mean that the selected sponsor message is displayed to the consumer. Appropriate clarification is required.

Claim 1 recites the transaction event. However, there is insufficient antecedent basis for this limitation in the claim, since a transaction event was not previously recited. It is interpreted to mean that the number of times the sponsor message has been presented is recorded. Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. *Claims 1, 3, 5, 6, 10, 11, 17, 18, and 24-26 are rejected under 103(a) as being anticipated by Kaplan (Patent Number 5,963,916 hereinafter Kaplan) in view of Davis et al. (Patent Number 6,269,361 hereinafter Davis).*

In reference to claim 1, Kaplan teaches a method for offering incentives related to purchases of media products or services over a communications network, said method comprising the steps of: selecting a sponsor message to be associated with the media product or a service, said sponsor message being selected from a plurality of sponsor messages, wherein each sponsor message is associated with a product or a service provided by a sponsor (i.e. selecting previews) (col. 2 lines 65 to col. 3 lines 16, col. 4 lines 20-40, col. 13 lines 10-18, and Figure 18); offering to a consumer the media product or service for sale, wherein said offer for sale is made to the consumer over a communications network (col. 17 lines 47-57, col. 18 lines 1-9, and Figures 53-55); offering to said consumer an incentive related to the purchase of said media product or service on the precondition that the consumer agrees to receive or interact with an interposed communication (i.e. an incentive is offered is the consumer agrees to answer a question or even listen to a music sample) (col. 7 lines 14-24, col. 8 lines 45-51, and Figures 4, 19, and 20); receiving, from the consumer, a request to receive or interact with an interposed communication (col. 7 lines 14-24, col. 8 lines 45-51, and Figures 4,

19, and 20); display the selected sponsor message to the consumer (Figure 18); and if the sponsor message is an interactive message, presenting at least one query to the consumer (col. 8 lines 45-51 and Figure 4); providing the offered incentive to the consumer (col. 7 lines 14-24).

Kaplan is silent about the method wherein said step of selecting includes verifying that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the sponsor message; recording the transaction event with the consumer to an activity log, said step of recording including updating the number of times the sponsor message has been presented; and receiving payment from the sponsor of the sponsor message presented. Davis teaches the method wherein said step of selecting includes verifying that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the sponsor message (i.e. the advertisement listing will be suspended if the account is used up) (col. 13 lines 3-9 and col. 14 lines 1-8); recording the transaction event with the consumer to an activity log, said step of recording including updating the number of times the sponsor message has been presented (col. 13 lines 3-9 and col. 14 lines 1-8); and receiving payment from the sponsor of the sponsor message presented (col. 13 lines 3-9 and col. 14 lines 1-8). It would have been obvious to modify Kaplan to include in the step of selecting verifying that the total number of times which the sponsor message has been previously presented is less than a number of predetermined transaction cycles contracted by the sponsor of the

sponsor message; recording the transaction event with the consumer to an activity log, said step of recording including updating the number of times the sponsor message has been presented; and receiving payment from the sponsor of the sponsor message presented to enable the retailers to collect advertising revenue from the artists whose music consumers sample in the retail stores.

9. In reference to claim 3, *Kaplan* teaches the method, wherein said incentive includes a discount on the purchase of said *media* product (col. 7 lines 14-24).

5. In reference to claim 5, *Kaplan* teaches the method, wherein said incentive is providing the *media* product or service to the consumer free of charge (col. 7 lines 14-24).

10. In reference to claim 6, *Kaplan* teaches the method wherein said incentive includes providing information to said consumer (*i.e. consumer is provided a printed record of her preview screen*) (col. 8 lines 45-48, col. 13 lines 66 to col. 14 lines 3, and Figure 20).

11. In reference to claim 10, *Kaplan* teaches the method, wherein said *selected sponsor message* is a multimedia presentation (col. 2 lines 65 to col. 3 lines 16, col. 4 lines 20-40, col. 13 lines 10-18, and Figure 18).

12. In reference to claim 11, *Kaplan* teaches the method, wherein said *selected sponsor message* is one of an interactive survey, an audio message, a visual display, and an Internet website (col. 2 lines 65 to col. 3 lines 16, col. 4 lines 20-40, col. 13 lines 10-18, and Figure 18).

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13. In reference to claim 17, *Kaplan* teaches the method, further comprising the step of requesting said consumer to provide personal identification information (*col. 7 lines 4-10 and Figure 56*).

14. In reference to claim 18, *Kaplan* teaches the method wherein said identification information includes *one of* said consumer's e-mail address, *address information*, *gender*, and *age (i.e. demographic information includes age etc)* (*col. 7 lines 4-10 and Figure 56*).

15. In reference to claim 24, *Kaplan* teaches the method, further comprising the step of making payment to *the content provider of the media product* (*col. 18 lines 1-9 and Figures 54-57*).

16. In reference to claim 25, *Kaplan* teaches the method, wherein said *media* product is downloadable from the Internet by the consumer (*col. 4 lines 20-40 and 51-67, col. 10 lines 66 to col. 11 lines 20, and Figures 1-57*).

17. In reference to claim 26, *Kaplan* teaches the method, wherein said communications network *is one of the Internet, television cable network, telephone network, or satellite network* (*col. 4 lines 20-40 and 51-67, col. 10 lines 66 to col. 11 lines 20, and Figures 1-57*).

18. Claims 4 and 9 are rejected under U.S.C. 103(a) as being unpatentable over *Kaplan* in view of Official Notice.

In reference to claim 4, *Kaplan* does not teach the method, wherein said incentive includes paying for shipping and delivery charges related to the purchase of said product or service. Official Notice is taken that it is well known within the prior art

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to provide free shipping and delivery on the purchase of products to encourage users to buy the products from a vendor. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include providing free shipping and delivery of the software CD's to enable Internet access by the users, since a user may not want to go to the brick and mortar store to buy the product and to pick up the software CD and may instead prefer to buy products via phone, fax, or Internet instead to avoid having to make a trip to the store.

19. In reference to claims 9, *Kaplan teaches offering discounts for the purchase of products or services (col. 7 lines 14-24). Kaplan does not specifically teach the method, wherein said incentive includes in-store coupons for discounting purchase of products or services. Official Notice is taken that it is well known within the prior art to provide in-store coupons for discounting purchase of products or services to encourage the users to buy the products from a given retailer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in-store coupons for discounting purchase of products or services, since a user would be motivated to make the purchase right away if he receives an instant discount on his purchase.*

Response to Arguments

20. After careful review of Applicant's remarks/arguments filed on 03/28/2007, the Applicant's arguments with respect to claims 1, 3-6, 9-11, 17, 18, and 24-26 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

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21. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

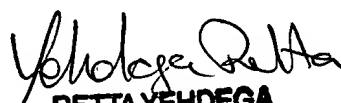
If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

October 10th, 2007


RETTA YEHDEGA
PRIMARY EXAMINER